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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,636	12/31/2003	William S. Liles JR.	125426-1088	9391
7590 12/01/2005				
KENNETH R. GLASER MICHAEL E. MARTIN GARDERE WYNNE SEWELL LLP 1601 ELM STREET, SUITE 3000 DALLAS, TX 75201		EXAMINER STRIMBU, GREGORY J		
		ART UNIT PAPER NUMBER		
		3634		

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/749,636	Applicant(s) LILES, WILLIAM S.	
	Examiner Gregory J. Strimbu	Art Unit 3634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/29/04</u> . | 6) <input type="checkbox"/> Other: ____. |

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "66" on line 6 of paragraph 18. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 2-11, 13, 14 and 16-20 are objected to because of the preamble of the claims does not agree with the independent claims from which they depend.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Recitations such as "a frame" on line 1 render the claims indefinite because it is unclear what element of the invention includes the frame. Recitations such as "a door" on line 5 of claim 1 render the claims indefinite because it is unclear if the applicant is referring to the door set forth above or is attempting to set forth another door in addition to the one set forth above. Recitations such as "at one end thereof" on lines 4-5 of claim 7 render the claims indefinite because it is unclear if the spring or the member includes the one end to which the applicant is referring.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9, 15-18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Mitsuhashi et al. Mitsuhashi et al. discloses a motorized operator for a swing door comprising a frame 15 adapted to support a motor 1 and a gear reduction drive mechanism 4 operably connected to said motor, said gear reduction drive mechanism including an output shaft 3 adapted to be operable for moving a door in one direction and in an opposite direction, an energy storage member 11 operably connected to said gear reduction drive mechanism, a member 5 mounted on said output shaft and drivingly engaged with a flexible member 6 connected to said energy storage member whereby in response to rotation of said output shaft in one direction energy is

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stored in said energy storage member and said energy storage member is operable to return energy through said flexible member to said output shaft to rotate said output shaft in an opposite direction. The chain includes opposed ends connected to an elongated shaft member 7. It should be noted that the end connected to the shaft member 8 is also connected to the shaft member 7 via the remainder of the chain. A member 9 engaged with the spring at one end of the shaft member 7. A link member (not numbered, but comprising the last link of the chain 6 connected to the shaft member 7). The frame includes a pair of spaced apart plates (not numbered, but shown in figure 1 supporting the bearings which support the output shaft 3) and opposed end plates (not numbered, but shown in figure 1 at the left and right ends of the frame).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10, 11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuhashi et al. as applied to claims 1-9, 15-18 and 20 above, and further in view of Porter. Porter discloses a frame 20 for a motorized operator wherein a motor 36 is mounted on one end of the frame while an energy storage member 63 is mounted on an opposite side of the frame.

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It would have been obvious to one of ordinary skill in the art to mount the motor and the energy storage member of Mitsuhashi et al. on opposite sides of the frame, as taught by Porter, to decrease the lateral dimension of the frame.

Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuhashi et al. in view of Kowalczyk et al. Mitsuhashi et al. discloses a motorized operator for a swing door comprising a frame 15 adapted to support a motor 1 and a gear reduction drive mechanism 4 operably connected to said motor, said gear reduction drive mechanism including an output shaft 3 adapted to be operable for moving a door in one direction and in an opposite direction, an energy storage member 11 operably connected to said gear reduction drive mechanism, a member 5 mounted on said output shaft and drivingly engaged with a flexible member 6 connected to said energy storage member whereby in response to rotation of said output shaft in one direction energy is stored in said energy storage member and said energy storage member is operable to return energy through said flexible member to said output shaft to rotate said output shaft in an opposite direction. The chain includes opposed ends connected to an elongated shaft member 7. It should be noted that the end connected to the shaft member 8 is also connected to the shaft member 7 via the remainder of the chain. A member 9 engaged with the spring at one end of the shaft member 7. A link member (not numbered, but comprising the last link of the chain 6 connected to the shaft member 7). Mitsuhashi et al. is silent concerning a spring that provides a return force when the output shaft rotates in two directions.

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However, Kowalczyk et al. discloses a swing door operator having a single spring 204 which is compressed when the door pivots in either direction.

It would have been obvious to one of ordinary skill in the art to provide Mitsuhashi et al. with a single spring, as taught by Kowalczyk et al., to reduce the cost of manufacturing the operator.

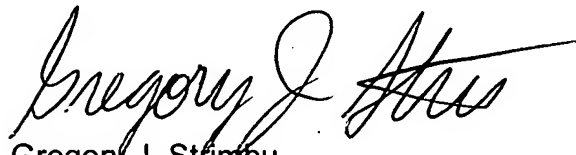
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Langeman, Dodge et al., Borgen, Hewitt, Sawyer, and Frantzen et al. are cited for disclosing a spring counterbalance system for a pivoting closure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 571-272-6836. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Gregory J. Stifimbu", with a stylized flourish extending from the end.

Gregory J. Stifimbu
Primary Examiner
Art Unit 3634
November 22, 2005